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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/672,378 05/28/96 ADACHI

M 960253/HG

EXAMINER

IM62/0709  
FRISHAUF, HOLTZ, GOODMAN, LANGER &  
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NEW YORK NY 10017-2023

PATTEN. JR.	PAPER NUMBER
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1722

DATE MAILED:

07/09/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on MARCH 2 AND 30, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-40 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
☒ Claim(s) 1-3, 5-12, 14-15, 20-29, 31-38 AND 40 is/are allowed.  
☒ Claim(s) 4, 13, 16-19, 30 AND 39 is/are rejected.  
☐ Claim(s) \_\_\_\_\_ is/are objected to.  
☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☒ The proposed drawing correction, filed on MARCH 30, 1999 is ☒ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.  
☒ ALL OF THE DRAWING FIGURES HAVE BEEN APPROVED BY THE DRAFTSPERSON.  
Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892.  
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 13  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

08/672,378

Art Unit: 1722

#### Detailed Action

1. Figures 15, 16, 18 and 73 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
2. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect(s) can be deferred until the application is allowed by the examiner.
3. Claims 4, 13, 16 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3 "a" should be --an--. In claim 4, line 3 and claim 30, line 2 there is no proper antecedent support for "the molten metal". In claim 13, line 3 there is no proper antecedent support for "the molten alloy". In claim 16, line 12 "form" should be --from--.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1722

5. Claim 16-19 and 39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 08/967,136. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to shaping a semi-solid metal including pouring a liquid alloy into a holding vessel having a thermal conductivity of at least 1 kcal/mh°C and adjusting the temperature of the vessel by induction heating.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


6. Claims 1-3, 5-12, 14, 15, 20-29, 31-38 and 40 are allowed.

7. Claims 4, 13 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication should be directed to Reed Batten at telephone number (703) 308-0471.

Batten/SJB

July 6, 1999

  
J. REED BATTEN, JR.  
PRIMARY EXAMINER  
GROUP 320 / 1722